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CHICAGO, IL 60606

In re Application of
Edara, et al.
Application No. 10/020,420
Filed: December 13, 2001
Docket No.: INS-120
For: SYSTEM AND METHOD OF UTILIZING
A HARDWARE COMPONENT TO EXECUTE AN
INTERPRETIVE LANGUAGE

DECISION REFUSING STATUS
UNDER 37 CFR 1.47(a)

This is in response to the petition under 37 CFR 1.47(a), filed July 5, 2002.

The petition is **DISMISSED**.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition under 37 CFR 1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. Failure to respond will result in abandonment of the application. Any extensions of time will be governed by 37 CFR 1.136(a).

The above-identified application was filed December 13, 2001 without an executed oath or declaration and naming Vidyasagar Edara, Paul Zimmerman, Yair Raz, and Anuradha Bommaji as joint inventors. Accordingly, on January 11, 2002, a "Notice to File Missing Parts of Nonprovisional Application" was mailed, requiring an executed oath or declaration and a surcharge.

A grantable petition under 37 CFR 1.47(a) requires: (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (2) an acceptable oath or declaration in compliance with 35 USC 115 and 116; (3) the petition fee; and (4) a statement of the last known address of the non-signing inventor.

The petition lacks requirements (1) and (4) stated above.

As to item (1), petitioner has failed to establish that the inventors cannot be reached or refused to sign the oath or declaration after having been presented with the application papers (specification, claims, drawings, and oath or declaration). Petitioner has not demonstrated that the inventors ever received a copy of the application papers (specification, claims, drawings, and oath or declaration).

Petitioner indicates that "formal papers" were forwarded to the non-signing inventors on January 24, 2002 and that to date they have not been returned. The declaration of Melissa Paraday

indicates that a declaration and assignment were mailed to each non-signing inventor. Petitioner has failed to establish that the inventors received the application papers (specification, claims, drawings, and oath or declaration) and thereafter refused requests to execute the oath or declaration.

Petitioner is reminded that before a refusal to sign an oath or declaration can be alleged, it must be demonstrated that a *bona fide* effort has been made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to each non-signing inventor. A copy of the application papers should be sent to the last known address of each non-signing inventor, or, if the non-signing inventor is represented by counsel, to the address of the non-signing inventor's attorney. See, MPEP 409.03(d).

Any renewed petition should be accompanied by evidence to establish that each non-signing inventor was sent a complete copy of the application papers and thereafter refused to execute the declaration. Petitioner may wish to provide the Office copies of letters sent to the inventors indicating the enclosure of the application papers (specification, claims, drawings, and oath or declaration). If after the inventors receive the application papers and requests to execute the oath or declaration are refused, these facts should be set forth in a statement of facts signed by the person to whom the refusals were made and detailing with specificity the exact manner of the refusals. If a written refusal has been made, a copy of the written refusal should be included on renewed petition.

As to item (4), the petition fails to set forth the last known addresses of the non-signing inventors. The Office is construing the last known addresses of the non-signing inventors to be that listed on the declaration submitted herewith. If the last known addresses of the non-signing inventors are other than that listed on the declaration, petitioner is required to provide the Office with the correct last known address of the non-signing inventors.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner for Patents
 Box DAC
 Washington, DC 20231

By FAX: (703) 308-6916
 Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23
 2201 S. Clark Place
 Arlington, VA

Telephone inquiries related to this decision may be directed to the undersigned at (703) 305-0310.


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Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy